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10/018,154	03/29/2002	Desinger Kai	2454	8873

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EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/018,154	Applicant(s) KAI, DESINGER	
	Examiner Charles A. Marmor, II	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 11, 12, 15, 16, 18, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 8-10, 13, 14, 17, 19-22, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is responsive to the Amendment filed December 17, 2004. The Examiner acknowledges the Substitute Specification; the amendments to the drawings; and the amendments to claims 1-26. Claims 1-26 are pending.

#### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

#### ***Drawings***

3. The drawings were received on October 12, 2004. These drawings are acceptable.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cutting element having a plurality of wire segments that form a closed curve with the hollow body as recited in claim 9; the gap at the proximal end of the displacement travel in the peripheral wall as recited in claim 12; the suction device as recited in claim 15; the HF-Voltage Source as recited in claim 18; the mechanical device for transferring cut-out tissue into the distal opening as recited in claim 24; a plurality of cutting elements as recited in claim 25; and the plurality of distal openings as recited in claim 26 must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### *Claim Objections*

5. Claim 5 is objected to because of the following informalities: in line 2, “the peripheral” apparently should read --a peripheral--. Appropriate correction is required.
6. Claim 8 is objected to because of the following informalities: in line 3, “groove or” apparently should be deleted since only a plurality of grooves are recited in claim 4. Appropriate correction is required.

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7. The Examiner suggests that Claim 11 be amended as follows:

11. (Proposed) A surgical hollow probe according to claim 1 wherein the cutting element is adapted to extend from and retract into the hollow body at at least one of the distal end and the proximal end of the displacement travel which extends parallel to the longitudinal axis.

8. Claim 12 is objected to because of the following informalities:

a. In line 2, "the distal end and /or at the proximal" apparently should read --at least one of the distal end and the proximal--.

b. In line 3, "travel in the" apparently should read --travel, in a--.

Appropriate correction is required.

9. Claim 14 is objected to because of the following informalities:

a. In line 2, "the radial and /or in the axial" apparently should read --at least one of the radial and the axial--.

b. In line 3, "the peripheral" apparently should read --a peripheral--.

Appropriate correction is required.

10. Claim 15 is objected to because of the following informalities:

a. In line 2, "characterised by" apparently should read --further comprising--.

b. In line 3, "the cut-out" apparently should be deleted.

Appropriate correction is required.

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11. Claim 16 is objected to because of the following informalities:

- a. In line 1, "13" apparently should read --15--.
- b. In line 4, "its entire length" apparently should read --an entire length thereof--.

Appropriate correction is required.

12. Claim 18 is objected to because of the following informalities:

- a. In line 2, "the surface" apparently should read --a surface--.
- b. In line 3, "that" apparently should be deleted.

Appropriate correction is required.

13. Claim 19 is objected to because of the following informalities: in line 2, "the surface" apparently should read --a surface--. Appropriate correction is required.

14. Claim 21 is objected to because of the following informalities: in line 2, "the first and/or the second electrode" apparently should read --at least one of the first electrode and the second electrode--. Appropriate correction is required.

15. Claim 23 is objected to because of the following informalities: in line 3, "(10)" apparently should be deleted. Appropriate correction is required.

16. Claim 24 is objected to because of the following informalities: in line 2, "the" apparently should be deleted. Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claim 12, 15, 16, 18, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "in the peripheral direction" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. There is no peripheral direction recited in the claims prior to this recitation.

Claim 15 recites the limitation "the hollow passage" in line 4. There is insufficient antecedent basis for this limitation in the claim. There is no hollow passage recited in the claims prior to this recitation.

Claim 15 recites the limitation "the proximal opening" in line 5. There is insufficient antecedent basis for this limitation in the claim. There is no proximal opening recited in the claims prior to this recitation.

Claim 16 recites the limitation "the proximal connection of the suction removal device" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the other terminal" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 23, the limitation "the one and/or the second electrode" recited in line 2 renders the claim indefinite. This limitation apparently should read -- at least one of the first electrode and the second electrode--.

Claim 24 recites the limitation "the proximal opening" in line 4. There is insufficient antecedent basis for this limitation in the claim. There is no proximal opening recited in the claims prior to this recitation.

***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1-3, 6, 7, 11, 15 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Ritchart et al. ('806). Ritchart et al. teach a surgical hollow probe for tissue removal. The probe (10) includes an elongate hollow body (12); a distal opening (14) at the distal end of the hollow body for receiving tissue; and an electrically conductive ring-shaped or loop-shaped cutting element (20). The cutting element (20) is adapted to be extended from or pivoted out of the hollow body transversely with respect to the longitudinal axis of the hollow body (column 8, lines 33-45). The cutting element is axially displaceable outside the hollow body along the hollow body. The cutting element is disposed in a plane that extends transversely with respect to the longitudinal axis and is displaceable in a parallel relationship to the longitudinal axis. The cutting element (20) is a flexible wire ring which is secured to a guide element (18) which displaced through a longitudinal groove (16) along the hollow body. A suction removal device



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(58) is provided that is connected to a vacuum source (13). A mechanical device (118) may be provided for transferring tissue into the distal opening.

***Allowable Subject Matter***

21. Claims 4, 5, 8-10, 13, 14, 17, 19-22, 25 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

22. Claims 12, 16, 18 and 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

23. The declaration filed on October 12, 2004 under 37 CFR 1.131 is sufficient to overcome the Burbank et al. ('727) reference.

24. Applicant's arguments, see pages 9 and 10, filed December 17, 2004, with respect to the rejection(s) of claim(s) 1-3 under 35 U.S.C. 102(e) as being anticipated by Burbank et al. ('727) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ritchart et al. ('806).


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*Conclusion*

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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March 4, 2005